

### REMARKS

Reconsideration of the present application, as amended, is respectfully requested.

#### **A. STATUS OF THE CLAIMS**

As result of the present amendment, claims 13, 16-21 remain in the case for continued prosecution.

Claims 17 and 20-21 are allowed.

Claim 12 has been amended to set forth what Applicants believe to be their invention more specifically. Especially  $T_1$ ,  $B_1$ , and  $B_2$  have been amended to recite the invention more specifically, for example, by incorporating the elements from the previously presented claims 14 and 15. Additional support can be found, for example in the Examples of the specification. Furthermore, informalities are removed from claim 12, such as some chemical structure drawings, for example <Formula 1>, are replaced with new ones for further clarification.


Claim 13 has been amended to conform to the amended claim 12.

Claims 14 and 15 have been canceled without prejudice.

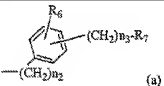
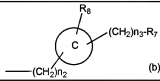
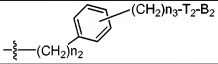
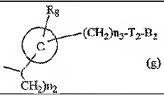

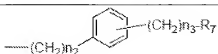
No new matter has been added.

#### **B. CLAIM REJECTIONS UNDER 35 U.S.C. § 112, FIRST PARAGRAPH**

On pages 3-7, claims 12-14, 16, and 18-19 are rejected under 35 U.S.C. § 112, first paragraph, for allegedly failing to comply with the written description requirement. The Examiner indicated that Applicant has failed to show that he was in possession of all the diverse compounds encompassed by the general structure of Formula I. Based on his own review, which we found close to accurate, of the 44 examples on pages 44-136 of the specification, the Examiner suggested that Applicant provides a more specific and narrower definition of the  $R_1$  substituents by:

- 1) eliminating the compounds wherein  $B_1$  is d), e), f), g), h), i) and j) from claim 12 for which there are absolutely no examples;
- 2) by narrowing down the term heterocycle corresponding to  to the heterocycles disclosed in claim 15; and
- 3) by narrowing down the definition of  $T_1$  to  $-NHCO-$ .

Applicants respectfully traverse. As amended herein, claims 12-14, 16, and 18-19 are supported by sufficient written description in the specification. Without admitting the appropriateness of the Examiner's position and for the purpose of facilitating prosecution, claims have been amended to incorporate most of the Examiner's suggestion. For example, claim 12 has been amended and is drawn to compound of formula 1, wherein  $T_1$  is  $-N(R_5)C(=O)-$ , and compounds in the present specification contain  $R_5$  as hydrogen or  $C_{1-5}$  alkyl group such as methyl. Also,  $B_1$  is selected from four structures, which include re-drawn chemical compounds of the previous presented (a), (b), (g) and (f) where  $R_6 = H$  as supported by original disclosure, and  $B_2$  is also amended to those two structures. In addition, claim 12 contains  $B_1$  and  $B_2$  supported by the examples of compounds in the instant specification. For the convenience of the Examiner and to facilitate the prosecution, Applicants provide table below containing compounds nos. which support each elements in  $B_1$  and  $B_2$ , as amended herein.

<b>B<sub>1</sub></b>	<b>Compound No.</b>
 <p>(a)</p>	3, 4, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 20, 23, 24, 35, 36, 37, 38, 39, 40, 41, 42, 43, 44
 <p>(b)</p>	1, 2, 5, 6, 21, 22
	29, 30, 31, 32, 33, 34
 <p>(g)</p>	25, 26, 27, 28
<b>B<sub>2</sub></b>	<b>Compound No.</b>
 <p>(c)</p>	26, 28, 30, 32, 34
	25, 27, 29, 31, 33

Therefore, Applicants would like to draw the Examiner's attention that the instant claims, as amended herein, are properly supported by the specification and thus, comply with the written description requirement.

On pages 7-12, claims 12-14, 16, and 18-19 are rejected under 35 U.S.C. § 112, first paragraph, for allegedly failing to comply with the enablement requirement. The Examiner indicated that the claims are very broad in terms of the number of compounds claimed and the actual compounds disclosed show a very narrow set of R<sub>1</sub> substituents. Furthermore, the Examiner indicated that determining how to make a particular compound, wherein the compound has a substituent R<sub>1</sub> which is not included in claim 17 (or pages 44-136 of the specification), would require testing new synthetic pathways for the different compounds and a person of ordinary skill in the art would have to engage in undue experimentation with no assurance of success. Continuously, on page 14, claim 15 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicants respectfully traverse. As explained above, without admitting the appropriateness of the Examiner's position and for the purpose of facilitating prosecution, claim 12 has been amended to encompass compounds whose synthetic method is either presented in the specification or can be easily deduced from the method presented in the specification or by the well-known organic chemistry by those ordinary skill in the art without further experiments. Thus, as amended and explained herein, including tables presented above, it is urged that claims 12-14, 16, and 18-19 are enabled as supported by the instant specification.

As amended herein, the instant claims are drawn to compounds prepared and presented in the specification or its simple analogous. Any compounds not presented or prepared in the specification directly is a simple variation, which can be prepared by the same or similar synthetic method presented in the application. The present specification provides a preparation method for tricyclic compounds encompassed by Formula 1 of the instant claims, on pages 17-41 in detail. The diversity of compounds encompassed by the general structure of formula 1 in the instant claims, as amended and presented herein, are such that those ordinary skills in the art can utilize the synthetic method in the application to prepare the compounds not prepared in the specification.

Also the method provided in the specification and the variety of compounds prepared in the specification is large enough that the degree of unpredictability in synthesis is very low and no undue experimentation is required, unlike to what the Examiner indicated on pages 8-9 of the Office Action.

On page 14, the Examiner indicated that claim 15 is objected to but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claim 12, as amended herein, is equivalent to a independent form of previously presented claim 15 with the limitations of the base claim. Therefore, it is respectfully urged that in addition to the allowed claims 17, 20 and 21, claims 12-13, 16, and 18-19 are also in allowable as a result of the current amendment, wherein claims 13, 16, and 18-19 which directly or indirectly depend from the properly amended claim 12. All dependent claims should be considered within the limitations of the independent claim, which is claim 12.

For all of the amendments and reasons above, reconsideration and withdrawal of this and future rejections is respectfully requested.

**C. FEES**

This response is being filed within the shortened period for response. No fee is believed to be required. If, on the other hand, it is determined that any fees are due or any overpayment has been made, the Assistant Commissioner is hereby authorized to debit or credit such sum to Deposit Account No. 02-2275.

Pursuant to 37 C.F.R. 1.136(a)(3), please treat this and any concurrent or future reply in this application that requires a petition for an extension of time for its timely submission as incorporating a petition for extension of time for the appropriate length of time. The fee associated therewith is to be charged to Deposit Account No. 02-2275.

An early and favorable action on the merits is earnestly solicited.

**D. CONCLUSION**

In view of the actions taken and arguments presented, it is respectfully submitted that each and every one of the matters raised by the Examiner have been addressed by the present amendment and that the present application is now in condition for allowance.

It is respectfully urged that the Examiner contact the undersigned with any question.

An early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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